

REMARKS / ARGUMENTS

The present application includes pending claims 1-30, all of which have been rejected. By this Amendment, claims 1-5, 8-15, 18-21 and 27 have been amended, as set forth above, to further clarify the language used in these claims and to further prosecution of the present application. The Applicant respectfully submits that the claims define patentable subject matter.

Initially, the Applicant notes that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the *initial review* of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, Office personnel *should* state *all* reasons and bases for rejecting claims in the *first* Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, Office personnel should indicate how rejections may be overcome and how problems may be resolved. A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.

See Manual of Patent Examining Procedure (MPEP) § 2106(II). As such, the Applicant assumes, based on the goals of patent examination noted above, that the present Office Action has set forth "all reasons and bases" for rejecting the claims.

THE SPECIFICATION

The Examiner states the following in the Office Action:

A preliminary examination of this application reveals that it includes terminology which is so different from that which is generally accepted, in the art to which this invention pertains that a proper search of the prior art cannot be made. For example: television, beginning on page 5, is described as having the ability to "utilize or arrange the delivery of media to [a] media peripheral" and further mentions the television "retriev[ing] stored media and transfer[ing] the stored media." Currently one of ordinary skill in the art would not describe a television as a device that either generates commands or controls media transfers from one physical location to another, but instead would describe a television in terms more consistent with wordnet.princeton.edu's definition, which is "an electronic device that receives television signals and displays them on a screen."

Applicant is required to provide a clarification of these matters or correlation with art-accepted terminology so that a proper comparison with the prior art can be made.

See the Office Action at page 2. Apparently the Examiner is relying on the use of the term "television" in the specification and alleges that it requires clarification. The Applicant respectfully disagrees and submits that the specification is sufficiently clear and no further clarification is required.

The Examiner is referred to, for example, Figure 1 and corresponding paragraphs 28-49 or Figures 9A-9B and corresponding paragraphs 93-98, where it is explained that a television may be used in connection with, for example, a media processing system (such as, for example, MPS 116 in Figure 1 or MPU 904 in Figure 9A), providing for user interface functionality, distributed storage

functionality, networking functionality, and control and monitoring of media devices (please see paragraph 30 or paragraph 95, for example). Therefore, the Applicant submits that the specification, when interpreted with the figures, is sufficiently clear and the objection should be withdrawn.

THE CLAIMS

The Examiner has rejected claims 1-2, 4, 8-9, 11-12, 14, 18-19, and 21-24 under 35 USC 112, second paragraph. The Office Action states the following:

The term "television" in claims 1, 2, 4, 8, 9, 11, 12, 14, 18, 19, 21 - 24, and 27 - 30 is used by the claim to mean a device capable of "controlling devices . . . and generating at least one command that causes the delivery of media" and further "controlling the delivery of the media" (pg. 4 and 5), while the accepted meaning is "an electronic device that receives television signals and displays them on a screen" (as defined by wordnet.princeton.edu). The term is indefinite because the specification does not clearly redefine the term.

See the Office Action at page 3. The Applicant respectfully disagrees with this rejection. As already explained above, the term "television" as used in the claims, is sufficiently clear in light of the specification. Nevertheless, in order to further prosecution of the present application, the Applicant has amended claims 1, 11, 21, and 27 to clarify that term "television" is used in connection with a media processing system.

The undersigned attorney for Applicant also explained the above argument and claim amendments in a telephone call with the Examiner on March 15, 2007. The Examiner agreed that the amendments to claims 1, 11, 21, and 27 would be sufficient to overcome the rejection under 35 USC 112, second paragraph. The Applicant submits that the rejection of claims 1-2, 4, 8-9, 11-12, 14, 18-19, and 21-24 under 35 USC 112, second paragraph, should now be withdrawn.

REJECTION UNDER 35 U.S.C. § 102

Claims 1-30 stand rejected under 35 U.S.C. §§ 102(a) and 102(b) as being anticipated by ReplayTV 4000 User Guide, published by SONICblue Incorporated (hereinafter, SONICblue). The Applicant respectfully traverses these rejections at least based on the following remarks.

I. SONICblue Does Not Anticipate Claims 1-30

The Applicant first turns to the rejection of claims 1-30 under 35 U.S.C. §§ 102(a) and 102(b) as being anticipated by SONICblue. With regard to the anticipation rejections under 102(b), MPEP 2131 states that “[a] claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” See Manual of Patent Examining Procedure (MPEP) at 2131 (internal citation omitted).

Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See *id.* (internal citation omitted).

A. Rejection of Independent Claim 1 under 35 U.S.C. §§ 102(a) and 102(b)

With regard to the rejection of independent claim 1 under 102(a) and 102(b), the Applicant submits that SONICblue does not disclose or suggest the limitation of "controlling communication of the media from a television within a media processing system, without consuming the media by said television," , or "transferring the media from a first location to at least a second location *according to said controlling communication by said television*", both as recited by the Applicant in independent claim 1.

The Office Action states the following:

SONICblue shows a method of controlling the communication of media from a television without consuming the media by said television, and transferring the media from a first location to at least a second location according to said controlling communication by the television (pg. 55). As this method is enabled by the SONICblue software, which comprises a computer program stored on a computer readable medium, claim 11 is inherently disclosed as well.

See the Office Action at page 4. The Applicant points out that the SONICblue document reference is a User Guide for a "ReplayTV" digital video recorder (DVR). The ReplayTV DVR is also featured at www.replayTV.com. The

Applicant also points out that the SONICblue document discloses only functionalities provided by the ReplayTV DVR, with all media processing and media communication functionalities being controlled by the DVR and not by a TV. In fact, the SONICblue document does not disclose a TV that controls any media communications, including transfer or exchange of media between two locations, without consuming the media. Even though the SONICblue document discloses network functionalities for the ReplayTV DVR (See SONICblue, at page 55), the communication of media is achieved via the DVR and not via a TV. Therefore, the Applicant maintains that SONICblue does not disclose or suggest at least the limitation of "controlling communication of the media from a television within a media processing system, without consuming the media by said television," or transferring the media from a first location to at least a second location according to said controlling communication by said television, both as recited by the Applicant in independent claim 1.

Accordingly, independent claim 1 is not anticipated by SONICblue and is allowable. Independent claims 11, 21 and 27 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 11, 21 and 27 are also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 1.

B. Rejection of Dependent Claims 2-10, 12-20, 22-26 and 28-30

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11, 21 and 27 under 35 U.S.C. §§ 102(a) and 102(b) as being anticipated by SONICblue has been overcome and requests that the rejection be withdrawn. Additionally, claims 2-10, 12-20, 22-26 and 28-30 depend from independent claims 1, 11, 21 and 27, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 2-10, 12-20, 22-26 and 28-30.

CONCLUSION

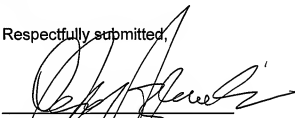
Based on at least the foregoing, the Applicant believes that all claims 1-30 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

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Respectfully submitted,



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